

## REMARKS

The foregoing amendment and these remarks are respectfully submitted in response to the Office Action of November 30, 2004, and are believed to overcome all of the issues set forth therein.

Claims 1-39 are currently pending in the application. However, claims 10, 11, 13, 26, 28, and 29 have been withdrawn from further consideration pursuant to a restriction requirement.

Claims 15-18 and 34-36 have been found allowable, but objected to as being dependent upon a rejected base claim. Allowable claims 15-18 have been rewritten in independent form as new claims 40-43, and thus Applicant believes that the objections to previously applicable to Claims 15-18 have now been overcome.

Claims 1-3, 5-9, 12, 14, 20-25, 27, and 37-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swanson, U.S. Patent No. 4,365,710 (“Swanson”), Villemure, U.S. Patent No. 5,647,191 (“Villemure”), and paragraphs [0002] and [0003] of Applicant’s specification. Additionally, claims 4 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swanson, Villemure, paragraphs [0002] and [0003] of Applicant’s specification and Fujiwara, U.S. Patent No. 5,722,584 (“Fujiwara”). Claims 30-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swanson, Villemure, paragraphs [0002] and [0003] of Applicant’s specification and Winski, U.S. Patent No. 5,269,645 (“Winski”).

After reviewing the Examiner’s comments and the cited references, Applicant has amended the application to more clearly set forth the present invention. In light of this amendment and the reasons explained more fully below, Applicant respectfully traverses the Examiner’s rejection and requests reconsideration.

### I. Brief Summary of the Claimed Invention

The claimed invention relates to a method of simultaneously making a plurality of composite cartons on a common assembly surface. In the claimed method, cartons in a layer are positioned en masse on a common assembly surface, such as a pallet. In each such composite carton, two or more singular cartons are joined such that an integral composite carton results. All of the joined singular cartons in the composite cartons remain joined together when the composite carton is removed from the assembly surface by lifting one of the singular cartons.

## **II. Summary of the Cited References**

Applicant notes that three of the references cited in the Office Action (Swanson, Villemure and Winski) do not even disclose a method of making a carton, let alone a method of making a composite carton, and the other cited reference (Fujiwara) discloses only an individual carton, not a composite carton. More specifically:

- Swanson teaches a method of arranging wax treated paperboard cartons on a pallet using adhesive to stabilize the pallet load;
- Villemure discloses a method of arranging paper reams on a pallet so that cartons are even not used;
- Winski discloses a method of handling materials on a pallet using a tacky spacing sheet between each pallet layer; and
- Fujiwara discloses a display carton in which a portion of the carton blank can be removed during carton assembly and used as a partition between items in the carton.

The Office Action combines these references with Applicant's statement regarding the known desirability of composite cartons and asserts that Applicant's claimed invention would have been obvious to one of ordinary skill in the art. In Applicant's view, and as more thoroughly discussed below, this position reflects an impermissible use of hindsight. A more detailed discussion of each of these references is found below.

With respect to U.S. Patent No. 4,365,710 to Swanson, Applicant respectfully disagrees with the Office Action assertion that "Swanson discloses a method of simultaneously making on a common assembly surface a plurality of composite cartons . . .," for two reasons. First, Swanson does not teach a method of making cartons – Swanson teaches a method of arranging cartons on a pallet using adhesive between each pallet layer to increase pallet stability. Second, even if the pallet loading method disclosed in Swanson could somehow be construed as a method of making cartons, the making of cartons presumably taught in Swanson does not occur simultaneously, as cartons are loaded on the pallet one at a time (see Fig. 4 and col. 4, ll. 40-55).

Moreover, two significant teachings of Swanson not mentioned in the Office Action are (1) that adhesive is applied to each carton on the pallet (see col. 2, ll. 37-45) and (2) the glue applied must allow for each carton to be pulled apart from the adjoining carton to which it is adhered when unloading the pallet. (see col. 2, ll. 37-45). It would thus not be logical for one of ordinary skill in the art to look to Swanson when seeking to create a composite carton because not only does Swanson not teach anything about carton creation, but also Swanson teaches that when a carton is pulled from a loaded pallet, such carton releases from the underlying carton to which it is adhered.

The Office Action also relies upon Applicant's specification for the proposition that it is known to form composite cartons comprising a first singular carton adhered to a second singular carton. Then the Office Action cites to U.S. Patent No. 5,647,191 (Villemure) for the proposition that "it is known to stack in such arrays on a pallet." (emphasis added). In Applicant's view, the Office Action fails to appreciate that (1) the items being stacked in arrays in Villemure are individual reams of paper, not cartons, and (2) one of the underlying objects of the invention disclosed in Villemure is to eliminate the use of cartons entirely. The background of Villemure (col. 1, ll. 31-40) sets forth the disadvantages of packing paper reams in cartons, which include the difficulty of displaying paper reams in cartons and the waste created by cutting the cartons away in order to display the paper reams. Indeed, the Summary of Villemure (col. 1, ll. 46-50) states that an object of the disclosed invention is to avoid the wasting of cartons. This object is accomplished by not using cartons in the Villemure method. Applicant submits that one of ordinary skill in the art seeking to create a composite carton containing items would not look to a reference such as Villemure that discloses a method to eliminate the use of cartons so the items typically contained in the cartons could be displayed without using cartons at all.

The Office Action also cites U.S. Patent No. 5,722,584 to Fujiwara and to U.S. Patent No. 5,269,645 to Winski. With respect to Fujiwara, Applicant notes that Fujiwara does not disclose a composite carton, but rather discloses a display carton in which a portion of the carton blank (the "longitudinal cutout partition flap 8") forms a "cross-shaped partition wall" when the display carton is assembled. (see Fig 4A, item 8). With respect to Winski, Applicant notes that Winski teaches (1) the use of a "special spacing sheet" under each layer of items stacked on a pallet in order to bond all items in a pallet layer to each other (col. 3, ll. 27-35) and (2) that a top

layer of items on a pallet can be pushed off of the layer of item adjacently underneath (col. 3, ll. 45-50). Thus, neither of these references teach or suggest the desirability of a composite carton, more less how to construct one.

### **III. The Proposed Combinations of Cited References Fail to Establish a Prima Facie Case of Obviousness**

Applicant respectfully submits that the Office Action's proposed combinations of various references fail to establish a prima facie case of obviousness. Three criteria are required to establish a prima facie case of obviousness: (1) there must be some suggestion or motivation to modify a reference or combine reference teachings; (2) there must be some reasonable expectation of success in the proposed modification or combination; and (3) the proposed reference modification or combination must teach or suggest all elements of the claimed invention. M.P.E.P. §.2143. The proposed combinations of cited references fail to satisfy these requirements because there is no suggestion or motivation for one of ordinary skill in the art to make the proposed combinations and because, even if made, the proposed combinations fail to teach or suggest all elements of the Applicant's claimed invention.

#### **A. There is no Suggestion or Motivation for One of Ordinary Skill in the Art to Combine the Cited References as Proposed**

Each rejection under 35 U.S.C. §103(a) in the Office Action relies, at a minimum, upon a combination of Swanson, Villemure and Applicant's statement regarding the desirability of packaging goods in cartons created from individual cartons. After careful review of these references, Applicant respectfully submits that no suggestion or motivation exists to make any of the proposed combinations of references set forth in the Office Action.

##### **1. The Swanson and Villemure References Teach Away from the Present Invention**

The Swanson and Villemure references each teach away from the present invention in at least three ways. First, both Swanson and Villemure explicitly teach that the adhesive used between adjacent cartons (in Swanson) and paper reams (in Villemure) must not allow adjacent cartons/reams to remain joined when one carton/ream is removed from the pallet stack. (See

Swanson at col. 2, ll. 40-45; Villemure at col. 4, ll. 52-62). This is because neither Swanson nor Villemure disclose methods of making a composite carton but instead each of these references discloses a method of stacking items on a pallet in which an adhesive is used for the purpose of stabilizing the pallet load, not for the purpose of joining items on the pallet together as a composite carton. In contrast, in the claimed method vertically adjacent cartons that have been adhered together remain joined as a composite carton when one of the adjacent singular cartons is lifted from the pallet stack.

Second, both Swanson and Villemure teach that cartons (in Swanson) and paper reams (in Villemure) are loaded unto the pallet individually – not *en masse* as is done in the claimed method. As depicted in Figure 4 and discussed at col. 2, ll. 37-39, Swanson teaches that cartons are stacked individually in order to construct a stack. Likewise, Villemure also teaches that individual reams are loaded on the pallet: “each ream is wrapped with paper wrapping . . . and is delivered to a palletizer having associated therewith an adhesive applicator” (col. 4, ll. 19-22) (underline added). The palletizer, in turn, “delivers individual packaged reams in layer formation as described hereinbefore on a pallet.” (col. 4, ll. 23-25) (underline added).

Third, both Swanson and Villemure teach the desirability of applying an adhesive on all (in Swanson) or at least some (in Villemure) items in each layer of items on the pallet. Thus, in these references, at least some items in each layer are adhered to adjacent items. In the present invention, on the other hand singular cartons are adhered to a corresponding carton to form composite cartons, but composite cartons on the pallet are not adhered to other cartons. Thus, in the embodiment of the present invention in which composite cartons formed by two singular cartons are created, there will not be adhesive on top of cartons in every second layer in the pallet stack. In the embodiment of the present invention in which composite cartons formed by three singular cartons are created, there will not be adhesive on top of cartons in every third layer in the pallet stack.

Because the Swanson and Villemure references teach away from the claimed invention, Applicant submits that such references cannot properly be combined with the other cited references to render the claimed invention obvious. M.P.E.P. § 2145.

**2. Modifying any of the References According to the Teachings of Villemure Would Render those References Unsuitable for their Intended Purposes**

The Office action relies upon Villemure as teaching one of ordinary skill in the art a stacking pattern that renders the claimed invention obvious. Applicant respectfully submits that modification of any of the cited references according to the teachings of Villemure would render those cited references unsuitable for their respective intended purposes and thus there is no suggestion or motivation to make the proposed modification. M.P.E.P § 2143.01.

As discussed above, Villemure teaches a method in which items such as paper reams that are normally packaged in a carton can be stacked directly on a pallet without the need for the cartons, and thereby eliminate carton waste. Indeed, this is an explicit object of the Villemure invention. (See col. 1, ll. 46-48).

Swanson, on the other hand, relates to wax-treated cartons used for packaging items such as meats and vegetables that need to be shipped in ice or contain high moisture contents. (col. 1, ll. 15-41; col. 2, ll. 12-18). It is simply not possible to reconcile the teachings of these two references, as applying the Villemure teaching that items should be stacked directly on the pallet without their associated cartons to Swanson would clearly render Swanson unsuitable for its intended purpose.

This same rational applies equally to other the other references cited in the Office Action, all of which relate to cartons. One of ordinary skill in the art would not be motivated to combine Villemure with any of these cited references since Villemure teaches a method to eliminate carton usage and the other cited references teach methods specifically dependent upon carton usage.

**3. Modifying any of the References According to the Teachings of Villemure Would Change the Principle of Operation of the Cited References**

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. § 2143.01. Applicant respectfully submits that such is the case with the rejections set forth in the Office Action.

The Office Action suggests that it would have been obvious for one of ordinary skill in the art to combine the teachings of Villemure with other references in order to render Applicant's claimed method of making a composite carton obvious. But, as discussed above, Villemure actually teaches a method of stacking items on a pallet that eliminates the use of cartons for items (i.e., paper reams) that are typically packaged in cartons and stacked in cartons on a pallet. It is simply not possible to reconcile this teaching of Villemure with the teachings of the other cited references – which all disclose methods in which items packaged in cartons are stacked on a pallet. Combining Villemure with the other cited references would necessarily require a change in the principle of operation with respect to carton usage of either Villemure or of the other reference with which Villemure is combined. For this reason, there is no suggestion or motivation for one of ordinary skill in the art to make any of the proposed combinations.

**4. Winski Teaches Away from the Proposed Combinations and Would Render the Other References Unsuitable for their Intended Purposes**

The Office Action proposes that a combination of Winski with various other cited references is sufficient to render several claims in the present application obvious. Applicant respectfully disagrees with this assertion. Not only does Winski teach away from the proposed combinations, but such combinations if made would render the other references unsuitable for their intended purposes.

Winsky teaches the use of a spacing sheet between each layer of items stacked on a pallet. (col. 7, ll. 44-68). The bottom surface of this spacing sheet is tacky and serves to bond all items in a layer together. The upper surface is not tacky and is intended to provide a surface upon which an adjacent layer of items may slide. Winski teaches that it is generally desirable for the spacing sheet to have significant weight. (col. 7, ll. 61-64).

Thus, while the principle of operation for stabilizing a pallet taught in Swanson and Villemure is use of an adhesive applied directly upon the items stacked onto the pallet, Winski teaches a different principle — that a separate spacing sheet should be adhered to all items in each layer of a pallet as a way to stabilize the pallet load. Because combining the teaching of Winski with the teaching of Swanson and Villemure would require a change in the principle of operation of Swanson and Villemure, there is no suggestion or motivation for one of ordinary

skill in the art to make such proposed combination.

In addition, combining the teachings of Winski with the teachings of Swanson or Villemure would render Swanson or Villemure unsuitable for their respective purposes. Swanson and Villemure both teach that items on a pallet should be freely releasable from adjacent items underneath so that items can be easily removed from the pallet. Applying a spacing sheet as taught in Winski – especially a spacing sheet of “significant weight” – would render the Swanson and Villemure inventions unsuitable for their intended purposes.

**B. Even if the Proposed Combinations of References Were Proper, the Claimed Invention Would Not Result**

Notwithstanding the lack of motivation or suggestion to combine the cited references as proposed in the Office Action, even if these references were somehow combined as proposed, the claimed invention would not result. In order for a proposed combination of references to render a claimed invention obvious, those references must teach or suggest all claimed elements. M.P.E.P. §2143.03. In this regard, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *Id.*

None of the cited references disclose or teach a method in which a plurality of singular cartons is placed en masse upon another plurality of singular cartons on an assembly surface. Indeed, the only cited reference that discloses the handling of items on a pallet in layers teaches that adjacent layers should not be in direct contact with each other, but rather should be separated by a special spacing sheet. In Applicant’s claimed invention, on the other hand, layers of adjacent cartons are placed – en masse – in direct contact with each other. The cited references, even if combined, fail to teach or suggest the positioning of a plurality of singular cartons en masse upon another plurality o cartons on a common assembly surface in accordance with Applicant’s claimed invention.

Similarly, none of the cited references teach or suggest the creation of a composite carton in which one singular carton remains joined to an adjacent singular carton when the uppermost singular carton is lifted off of the assembly surface. In fact, the primary references cited in the Office Action, Swanson and Villemure, actually teach the opposite - - i.e., that a lowermost carton or ream adhered to an upper carton or ream should separate from the uppermost carton when the uppermost carton is lifted off of the pallet or assembly surface.

Finally, none of the cited references, even of combined, teach or suggest a composite carton in which two separate cartons are glued together with an object in between the two cartons.

#### IV. Conclusion

In view of the reasons set forth above, the Applicant respectfully requests that the Examiner's rejections and remaining objections be withdrawn. An early notice of formal allowance is earnestly solicited. Should there be any questions regarding this application, the Examiner is invited to contact the undersigned at the number shown below.

Respectfully submitted,



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